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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,741	11/21/2003	C. Thomas Hendrickson	76597.010500	3150

22191 7590 09/24/2010

GREENBERG TRAURIG, LLP (DC/ORL)
2101 L Street, N.W.
Suite 1000
Washington, DC 20037

EXAMINER	
LUBIN, VALERIE	

ART UNIT	PAPER NUMBER
3626	

NOTIFICATION DATE	DELIVERY MODE
09/24/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPMAIL@gtlaw.com
SANTOSV@gtlaw.com
cadanoc@gtlaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/719,741	HENDRICKSON ET AL.	
	Examiner	Art Unit	
	VALERIE LUBIN	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52,73-87 and 89-97* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52, 73-87, 89-97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/13/10 has been entered.

2. Claims 1-52, 73-87, 89-97 are pending.

For reference purposes, the document paper number is 20100913.

Response to Amendment

3. The rejection of claims 73-87 under 35 U.S.C. 112, second paragraph is withdrawn in light of Applicant's amendments.

4. A new rejection under 35 U.S.C. 101 is introduced for claims 89-97.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 89-95 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Clam 89 is directed to a computer readable medium, which given the broadest reasonable interpretation, covers forms of non-transitory tangible media and transitory propagating signals per se. Signals are not patent eligible subject matter. Applicant should correct the claim to only include forms of non-transitory media.

Claims 90-97 are rejected under the above analysis.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-52, 73-84, 89-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risen Jr. et al. U.S. Patent No. 6,018,714 in view Heckman et al Pre-Grant Pub No. 2003/0061075.

10. With respect to claim 1, Risen recites a method comprising the steps of: determining a value associated with an asset (Col. 4 line 23); determining a change in value of the asset over a d of time (Col. 7 lines 38-64); determining a risk-of-loss to an asset attributable to an eligible event that can occur over the time period (Col. 1 lines 15-20, col. 21 lines 52-53); and using a computer program (Col. 11 lines 3-8) to determine a cost of indemnity against a loss to the object from the eligible event over the time period based on the change in value and the risk-of-loss (Col. 4 lines 24-25, col. 21 lines 47-50).

Risen does not specifically disclose the method for a landscape architectural object comprising woody trees and shrubs that appreciate over time; however Heckman discloses insuring agricultural land production (¶ 2). It would have been obvious to one of ordinary skill in the art to add the teachings of Heckman to Risen with the motivation of determining insurance coverage for a land, field or landscape on such field.

Claims 73, 89, 93 are rejected under the analysis of claim 1.

11. For claims 2-15 and 19-21, Heckman recites a risk-of-loss based on different attributes such as drought, hail, plant disease, insects, frost, etc (¶ 10). It would have been obvious to one of ordinary skill in the art to combine the teachings of Risen and Heckman to determine a risk-of-loss using such factors, because they impact the asset and contribute to its value over time.

Claims 79-83, 94 are also rejected under the above analysis.

12. For claim 16, Heckman recites using an event trend model to assist in developing an insurance plan (¶ 65). Risen and Heckman do not specifically disclose calculating a risk-of-loss based on an event trend model; however, Examiner takes Official Notice that such using trend models to develop risk and values was old and well known in the art at the time the invention was made . It would have been obvious to combine the prior art in order to determine realistic values.

Claims 17 and 18 are rejected under the analysis of claim 16, as the data used in the event trend model is a mere substitution of known data elements for other data elements that yield predictable results (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

Claims 47 and 48 are also rejected under the above analysis.

13. With regards to claim 22, Heckman recites determining the cost of the indemnity against the loss to the object based on certain data (¶ 104, 105). The data used in determining such a cost is a mere substitution of known data elements for other data elements that yield predictable results (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)). It would have been obvious to one of ordinary skill in the art to combine the teachings of Risen and Heckman Risen and Heckman in order to determine insurance coverage for different indemnity cost scenarios.

Claims 23-35, 84, 95 are rejected under the above analysis.

14. For claims 36 and 37 Heckman recites a risk-of-loss based on different attributes such as drought, hail, plant disease, insects, frost, etc (¶ 10). It would have been obvious to one of ordinary skill in the art to combine the teachings of Risen and Heckman to determine a risk-of-loss using such factors, because they impact the asset and contribute to its value over time.

15. With regards to claim 38, Heckman recites determining regional pricing information associated with at least one of a material cost of the landscape architectural object. Risen and Heckman do not specifically disclose determining an installation cost associated with an installing of the landscape architectural object in a landscape architectural setting. However, Examiner takes Official Notice that such a method was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art in order to obtain more specific cost information.

Claim 40 is rejected under the analysis of claim 38, as the data used to calculate regional pricing information a substitution of known data elements for other known data elements that produce predictable results (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

Claims 74-76, 90-92 are rejected under the analysis of claim 38.

16. For claim 39, Heckman recites aggregating pricing information associated with at least one geographic region (¶ 16). It would have been obvious to combine the prior art in claim 39 for the same motivation cited in claim 38.

Claims 41 and 42 are rejected under the analysis of claim 38, as the data contained in the regional pricing information is non-functional descriptive material that does not further limit the method step in claim 38 (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

17. For claim 43, Risen and Heckman do not specifically recite determining a change in the at least one of the material cost and the installation cost over time; however Examiner takes Official Notice that such a technique was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art in order to better estimate costs over a period of time.

Claims 44-46 are rejected under the analysis of claim 43.

18. With regards to claim 49, Risen and Heckman does not specifically recite determining a value associated with the landscape architectural object based on an aesthetic contribution of the object to a landscape architectural setting. However, Examiner takes Official Notice that determining objects' values based on aesthetics was old and well known in the art at the time the invention was made. It would therefore have been obvious to combine the prior art in order to more accurately value the landscape.

Claims 50-52 are rejected under the analysis of claim 49.

19. With respect to claim 77, Risen and Heckman do not specifically recite logic configured to determine at least one of a growth rate, a degradation rate, and appreciation

rate and a depreciation rate associated with the object over a period of time. However, Examiner takes Official Notice that determining the value of an object based on depreciation data was old and well in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art in order to determine more accurate values.

Claim 78 is rejected under the analysis of claim 77.

20. Claims 85-87, 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risen Jr. et al. U.S. Patent No. 6,018,714 in view Heckman et al Pre-Grant Pub No. 2003/0061075, further in view of Borghesi et al. U.S. Patent No. 5,950,169.

21. With regards to claim 85, Risen and Heckman do not recite the limitations of claim 85. However, Borghesi discloses: logic configured to receive a claim for the loss of an item (Col. 2 lines 41-45); logic to determine whether the loss is a total or partial loss based on information included in the claim (Col. 1 lines 42-47); logic configured to offer a settlement for the loss based on at least one of a cost to replace the object when the loss is a total loss, and one of a cost to recondition the object and an amount of diminished value of the object when the loss is a partial loss; and logic configured to pay the settlement for the loss when the settlement offered is accepted (Col. 5 lines 19-26). It would have been obvious to one of ordinary skill in the art to combine the teachings of Risen, Heckman and Borghesi in order to process insurance claims for a landscape object.

Claim 96 is rejected under the analysis of claim 85.

22. Claim 86 is rejected under the analysis of claim 85 as Borghesi recites costs to replace the object being based on at least material cost (Col. 6 lines 23-27).

23. For claim 87, Risen, Heckman and Borghesi do not specifically disclose logic to dispatch an appraiser at the location of the loss; however, Examiner takes Official Notice that such a technique was old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art to dispatch appraisers to the scene of a loss in order to enable the appraisers to directly evaluate the damages.

Claim 97 is rejected under the analysis of claim 87.

Response to Arguments

24. Applicant's arguments filed 7/13/10 have been fully considered but they are not persuasive.

25. Applicant argues that the cited references do not teach the claimed limitations because the prior art applies a method to an asset other than a landscape architectural object comprising woody trees and shrub. Examiner respectfully disagrees and maintains that the prior art reads over Applicant's method steps for insuring an asset. The particular characteristics of the asset in question, whether it be crops or trees do not functionally limit the method. Furthermore, crops and trees do in fact present similarities and face many of the

same risks such as drought, hail, frost, insects, plant diseases etc. as recited in Heckman (¶ 10).

26. Applicant argues that the prior art fails to suggest a risk of loss determination based upon an inspection. Examiner respectfully disagrees and refers Applicant to the Risen Col. 1 lines 15-20 where it is disclosed that due diligence is done to determine the value of an intellectual asset. Due diligence as noted by Risen comprises considering different aspects pertaining to the property, e.g. financial, legal, technical, etc. in order to determine a value and a risk of loss is based at least partly on the value of an asset. Performing due diligence on specific aspects of an asset thus constitutes a form of inspection.

27. Applicant also argues that the Examiner has not shown any need or problem that can provide reason for combining the elements of Risen and Heckman. Applicant is reminded that, there need not be an explicit teaching, suggestion or motivation to combine as long as there is a rationale that would have prompted one of ordinary skill in the art to combine the prior art. One of ordinary skill would have known to combine the teachings of Risen and Heckman because both methods would have performed the same functions when combined as individually and produced the same predictable results. Furthermore, both methods address the same general field of insuring an asset.

28. As stated in office action mailed on 02/04/10, the following assertions of fact have gone unchallenged and are considered admitted prior art:

• using trend models to develop risk and values was old and well known in the art at the time the invention was mad;

• determining an installation cost associated with an installing of the landscape architectural object in a landscape architectural setting;

• determining a change in the at least one of the material cost and the installation cost over time;

• determining the value of an object based on depreciation data was old and well in the art at the time the invention was made;

• logic to dispatch an appraiser at the location of the loss;

• determining objects' values based on aesthetics;

• determining the veracity of a document was old and well known in the art at the time the invention was made.

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. L./
Examiner, Art Unit 3626

/Dilek B Cobanoglu/
Examiner, Art Unit 3626